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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,972	02/28/2002	Ken-ichi Kosuna	1617.22B	3682
24040	7590	02/10/2004	EXAMINER	
MASON & ASSOCIATES, PA 17757 US HWY 19 N. SUITE 500 CLEARWATER, FL 33764			COE, SUSAN D	
		ART UNIT	PAPER NUMBER	
		1654	II	
DATE MAILED: 02/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/045,972	KOSUNA, KEN-ICHI
	Examiner Susan Coe	Art Unit 1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 August 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

**DETAILED ACTION**

1. The amendment filed August 18, 2003, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 1-21 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 16-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 16 and 21 are rendered indefinite by the use of parentheses in describing the ratios of the different "R" groups. The use of parentheses is considered indefinite because it cannot be determined when the enclosed limitation is or is not to be included in the claim. In addition, it is unclear how the ratios relate to the OH groups. It is unclear what percentage of each type of OH group are required. Claims 16 and 21 are also indefinite because the "R" groups do not use proper Markush language. Because of this, for "R" it is unclear if the bond position for the OH group must be the same for both "R's" in the structure.

***Claim Rejections - 35 USC § 102***

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/36497.

Applicant's claims are drawn to a polymer composition with an active ingredient isolated from buckwheat seeds. The polymer has a molecular weight of 1,000 to 10,000 and is a catechin-epicatechin polymer.

WO '497 teaches a polymer composition that meets the structural limitations of applicant's claims (see claim 19, page 174). It is noted that WO '497 does not teach isolating their polymers from buckwheat seeds. However, claims 1-20 are considered to be anticipated by this reference because the claims encompass any catechin oligomer that meets the limitations set forth in the claims. The claims are considered to encompass what is taught by this reference because the claims are product-by-process claims. MPEP 2113 states that:

PRODUCT-BY-PROCESS CLAIMS ARE NOT LIMITED TO THE  
MANIPULATIONS OF THE RECITED STEPS, ONLY THE STRUCTURE  
IMPLIED BY THE STEPS

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [original emphasis]

Therefore, since the product taught by WO '497 is identical to the claimed product, the product of WO '497 properly anticipates the claimed product.

WO '497 does not state that the polymer composition has the same effects on the body that are claimed by applicant; however, since the claimed composition is identical to the prior art

composition, the composition taught by WO '497 would inherently have the same effects on the body when ingested.

***Claim Rejections - 35 USC § 103***

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,554,645 in view of US Pat. No. 5,232,942.

Applicant's claim is drawn to using a polymer composition to improve memory.

WO '497 teaches a composition that meets the structural limitations of applicant's claims. WO '497 teaches that this composition is an antioxidant (see claim 19) but does not specifically teach administering the composition to improve memory. However, US '942 teaches that antioxidants can be used to treat senility (see column 1, lines 32-55). Based on this teaching by US '942, a person of ordinary skill in the art would reasonably expect that the antioxidant composition taught by WO '497 could be used to improve memory. Therefore, an artisan of ordinary skill in the art would have been motivated to administer the composition of WO '497 to improve memory.

6. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1654

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Susan Coe, Examiner  
February 5, 2004